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Customer Number

Patent  
Case No.: 58582US003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: **DAHAN, JEFFREY R.**

Application No.: **10/757,645**

Confirmation No.: **3942**

Filed: **January 13, 2004**

Title: **METHOD OF PRODUCING LITHIUM ION CATHODE MATERIALS**

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]**

I hereby certify that this correspondence is being:

- ☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at 571-273-8300.

Date

Signed by:

Dear Sir:

This is in response to the Office Action dated February 22, 2007. Claims 1-20 are pending. Claims 1-20 were restricted under 35 USC § 121 as follows:

I. Claims 1-15 are said to be drawn to a method of producing lithium nickel cobalt manganese oxide, classified in Class 29, subclass 623.1;

II. Claims 16-20 are said to be drawn to a lithium nickel cobalt manganese oxide, classified in Class 429, subclass 231.2;

A telephone call was made to Applicants representative on Feb. 12, 2007, but did not result in an election being made.

The Patent Office stated that the inventions listed in Groups I and II are related as process of making and product made and are distinct. Under MPEP § 806.05(f) the inventions are distinct if either or both can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process.

Applicants respectfully traverse the restriction requirement and request reconsideration and withdrawal of the restriction requirement.

Applicants submit that the inventions are so interrelated that a search of one group of claims will reveal art to the other. It is believed that the inventions of Groups I and II are so closely related in the Technical Field that a proper search of any of the claims would, by necessity, require a proper search of the other. Applicants note that when Group I is found patentable, Group II also should be found patentable. Thus, Applicants submit that all of the claims can and should be searched simultaneously. Even if the inventions are independent or distinct, Applicants respectfully note that the Examiner need not have restricted the application and therefore need not maintain the restriction. MPEP § 803 requires that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Thus, it is not mandatory to make a restriction requirement, even in situations where it may be deemed proper.

Were restriction to be effected between the claims in Groups I and II, a separate examination of the claims in Groups I and II would require substantial duplication of work on the part of the U.S. Patent and Trademark Office. Even though some additional consideration may be necessary, the scope of analysis of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group I were being considered alone. Clearly, this duplication of effort would not be warranted where these claims of different categories are so interrelated. Further, Applicants submit that for restriction to be effected between the claims in Groups I and II, it would place an undue burden by requiring payment of a separate filing fee for examination of the nonelected claims, as well as the added costs associated with prosecuting two applications and maintaining two patents.

Nevertheless, to comply with the requirements of 37 C.F.R. § 1.143, Applicants hereby elect Group I (i.e., claims 1-15) with traverse as noted above, and respectfully request reconsideration and withdrawal of the restriction requirement. Alternatively, should the Examiner maintain the restriction requirement, Applicants respectfully request rejoinder of the non-elected groups upon allowance of the claims of Group I. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a teleconference.

Respectfully submitted,

20-Mar-2007  
Date

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